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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/655,136	05/30/1996	BRUCE TOGNAZZINI	2860-014	8272
22852	7590	03/16/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/655,136	TOGNAZZINI, BRUCE
	Examiner Calvin L Hewitt II	Art Unit 3621 <i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 November 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,5-10,15 and 21-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,5-10,15 and 21-28 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

Status of Claims

1. Claims 1, 5-10, 15 and 21-28 have been examined.

Response to Amendments/Arguments

2. Regarding claims 1 and 21, Applicant is of the opinion that the prior art of Rose does not teach “user’s information being sent back to the user from the seller and stored in data memory for subsequent transactions”. However, this feature is not found in the claims and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Regarding claims 15 and 28, Applicant states, “there is no disclosure in Bezos ('399) of the feature of the seller sending customer information directly to the customer's memory for use in subsequent transactions”. Claims 15 and 28 do not recite sending *customer* information but merely “sending information stored in said seller memory”. “Sending information” is much broader than “sending customer information”. On page 15, lines 7-10, of the Applicant's Specification the Applicant refers to seller memory as it exists in the prior art, and prior art merchant memory comprises other information, in addition, to customer information. Nonetheless, Bezos et al. teach sending customer information

provided by a customer to a seller, from seller memory to customer memory for use in subsequent transactions (address data, credit card data- '399, figure 2; column 6, lines 33-40). The Applicant states that the prior art does not teach "seller [storing] customer information at the customer memory for subsequent transactions". However, this limitation is not found in the claims and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). The 112 rejection to claim 28 is maintained because it is not clear at what stage the "connecting" step takes place. For example, to one of ordinary skill the "connecting step" may only be associated with the "subsequent order". Note, the steps of "providing", "storing", and "confirming" are not directed to an order being placed or the exchange of order data.

Regarding claims 5-10 and 22-27, the Applicant is of the opinion that the prior art does not disclose "an external memory that loads information into the device memory that was received from the seller". The Applicant equates the above with an advantageous feature of the "seller storing customer information in the customer's device memory". However, the claim does not refer to "customer information" and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Regarding "seller memory",

this is non-functional data. The limitation of “wherein said information comprises card information relating to a telephone purchase and is received from a seller memory connectable to said external memory”, merely further describes the data. It is non-functional as it does, “alter how the machine functions (i.e., the descriptive material does not reconfigure the computer)” (MPEP, 2106, section VI). Nonetheless, Feldman teaches a device for loading autodialers with a phone number and unique customer personal codes (figure 3). To one of ordinary skill this information has to be programmed into the device memory. This task can be performed manually or automatically. In either case it comes from some “memory” be it human memory, a pad or notebook containing a list of numbers and codes, or a computer memory, such as a disk or CD-ROM, where the “seller” is the owner of the device or the service that provides customers with the autodialers (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 196 (CCPA 1958)). The Examiner has also applied a new 112 2nd rejection to claim 5 in light of the amendment to the preamble of claim 5.

The Examiner would like to apologize for a typographical error in the previous Office Action. Specifically, claims 15 and 22 were not in the 112 2nd rejection section. Claims 15 and 22 recite the same language as claims 28 and 5, respectively, and so the rationale, for making the 112, would have applied. In response to the 112 2nd, the Applicant did not amend claim 28 and removed the word “portable” from claim 5. Therefore, the Examiner is examining claims as if

claim 15 wasn't amended and the "word" portable was removed from the preamble of claim 22.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5-10, 15, 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 22 have been amended to be directed to a device. A limitation of the claim recites a seller memory connectable to external memory. However, the seller memory is not part of the portable device (Applicant's figure 1). Therefore, the Applicant has not clearly defined the subject matter that the Applicant regards as the invention.

Claims 6-10 and 23-27 are also rejected as they depend from claims 5 and 22, respectively.

Claims 15 and 28 are rejected as the claim recites performing "sending information stored in said seller memory from said telephone at the seller site to said customer memory for use during a subsequent order" steps without first connecting to a user's telephone (Specification, page/line 14/23-16/10). In

general, the claim does not provide one of ordinary skill a method for transferring data between customer and seller telephones. Specifically, the claim should recite an initiation of contact, a call or the like for enabling data to be transferred between devices.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al., U.S. Patent No. 5,757,917 in view of Sandig et al., U.S. Patent No. 5,737,610 and Remillard, U.S. Patent No. 5,396,546.

As per claims 1 and 21, Rose et al. teach a system for purchasing goods and services over the internet comprising: a telephone set connected to a telephone line (column 2, lines 50-62), a data interface connected to a telephone line (figures 1-3; column 2, lines 50-62; column/line 4/66-5/13), data memory for storing card information from a called station and a key for activating said data memory to send stored information to another called station (figure 1; column/line 7/35-8/25; column 8, lines 58-67). Rose et al. do not explicitly recite a card

reader and loading data from a data memory to a portable device. Sandig et al. teach downloading data from a called station over a telephone line, storing the data in data memory, and transferring the information from data memory, using a docking port, to a portable device having device memory (abstract; figure 1). Remillard teaches a telephone set connected to a telephone line with a data interface, data memory, a docking port for receiving electronic devices (abstract; figures 1-3 and 6A-B; column/line 5/56-6/61; column 8, lines 38-60) and a card reader for accessing goods and services online (column 3, lines 17-33). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rose et al. Sandig et al. and Remillard. Rose et al. teach a user obtaining goods and services from an internet warehouse over a telephone network using a credit card ('917, column 8, lines 1-12), to one of ordinary skill it would have been obvious to make the entering of credit card data more efficient by automating the process through the use of a card reader attached to the telephone set of Rose ('917, column 2, lines 50-62; '546, figures 1-3 and 6A-B). Further, by incorporating the teachings of Sandig et al. a user can access and download data using a telephone set connected to a telephone line ('610, column 2, lines 35-50; '917, column 2, lines 50-62; '546, figures 1-3 and 6A-B) for use in another electronic device or devices ('610, column 3, lines 32-55).

7. Claims 15 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos, U.S. Patent No. 5,715,399 in view of Bezos, U.S. Patent No. 5,727,163 and Dedrick, U.S. Patent No. 5,717,923.

As per claims 15 and 28, Bezos ('399) teaches a method for sending and receiving goods comprising: providing a telephone having a customer memory at a customer site for storing and sending information (figures 1 and 2) and connecting, by a telephone network, a telephone at a customer site with a telephone at a seller site while an order for goods is placed (abstract; column 5, lines 23-45) and storing in a seller memory of a telephone at a seller site, information provided by said customer (figure 3). Bezos ('399) doesn't specifically recite how the customer information was entered into the system. Bezos ('163) teaches customer information keyed in by personnel at a seller site (column 7, lines 23-50; column 9, lines 43-60). Bezos ('399) also doesn't explicitly teach confirming whether a customer's telephone is memory equipped. Dedrick teaches a system for providing customized information over a network to a user comprising confirming, on a display, properties of device memory (e.g. whether a customer's telephone is memory equipped) and sending information stored in seller memory for use during a subsequent order (column 4, lines 32-65; column 6, lines 60-63; column 11, lines 45-61; column 12, lines 26-40; column 16, lines 40-51). Therefore, it would have been obvious to one of ordinary skill to combine

the teachings of Bezos ('399), Bezos ('163) and Dedrick. Bezos ('399) teaches a system for sending and receiving orders for goods where a customer has previously placed at least one order, utilizing a secure protocol for exchanging credit card data between buyer and seller ('399, column 5, lines 24-31). Bezos ('163) provides a method for a seller to initially receive credit card data where the received data is keyed into a database for future use ('163, abstract; column 9, lines 44-60). Bezos ('399) also teaches confirming a credit card transaction comprising a seller sending an e-mail to buyer ('399, column 6, lines 19-50). Specifically, Bezos ('399) teaches an e-mail confirmation message that includes an advertisement ('399, column 6, lines 28-40). Dedrick teaches a method of providing users with customized advertisements based on a user profile and/or users variables ('923, column 11, lines 45-61; column 12, lines 26-40). One of the user characteristics that a seller can monitor is how the user consumes or processes electronic information (e.g. advertisements- '923, column 14, lines 52-54) such as audio, video, graphics, animation, text, etc. ('923, column 4, lines 44-55; column 5, lines 42-49; column 6, lines 33-52 and 60-63; column 11, lines 45-61). Therefore, it would have been obvious to one of ordinary skill to identify a customer's capabilities for consuming electronic information (e.g. whether a telephone is customer equipped) and provide advertisements to a user in the appropriate format and/or select out users who use a particular processing

device (e.g. memory) and send advertisements to only those users ('923, column 5, lines 34-49; column 11, lines 45-61).

8. Claims 5-10 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman, U.S. Patent No. 5,343,519 in view of Winebaum et al., U.S. Patent No. 4,941,172.

As per claims 5-10 and 22-27, Feldman teaches a portable device with memory (figure 3), a docking port for receiving card information from an external memory and received from a seller memory (figure 4; column 4, lines 41-62), where the device comprises: a converter for converting information from said device memory into an audible representation of the information (abstract), a send key for activating said converter and transmitting the audible representation, via a microphone of a telephone set, to a called station (column 4, lines 6-17), a plurality of keys for controlling a plurality of device memories each selectively storing data (figure 3; column 4, lines 25-41), a display for showing the contents of the device memory (figure 3), a digital to analog converter and an electro-acoustical transducer (figures 1-3), a plurality of keys for entering a password prior to loading information into said device and prior to activating said converter (column 2, lines 12-32; column 4, lines 35-55). Feldman does not specifically recite phone purchases. Winebaum et al. teach a pre-

programmed portable device with memory that converts information from said device memory into an audible representation of the information and transmits the audible representation, via a microphone of a telephone set to a called station (abstract; column 2, lines 41-65). The portable device can be a credit card (column 2, lines 36-48) and used to make a telephone purchase (e.g. purchasing a telephone or obtaining goods and services via telephone) (column 3, lines 35-50; column 8, lines 52-67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Feldman and Winebaum et al. in order to allow users to efficiently connect with service providers ('172, column 1, lines 16-23).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II
March 10, 2004

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600